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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

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Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/325.963

Applicant(s)

ALBRECHT ET AL

Examiner

Leanna Roche

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-17 and 25-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3

- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12 and 18-24, drawn to method of making breathable film, classified in class 264, subclass various.
- II. Claims 13-17 and 25-33, drawn to a breathable film, classified in class 428, subclass 316.6 and 318.4.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the claimed breathable film can be made by another materially different process such as casting followed by drawing rather than extruding followed by drawing.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Kim Villig on February 15, 2001 a provisional election was made with traverse to prosecute the invention of Group II, claims 13-17 and 25-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 and 18-24 are withdrawn from further

consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 32 recites the limitation "an A layer" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Tenneco Chemicals Inc. (GB 1321489).

Tenneco is directed to a flexible polyurethane foam from which a major proportion of the cell wall membranes have been removed (Column 1 lines 19-21). The polyurethane sheet is stretched to orient the pores so that they are parallel to the plane of the sheet, and then the membranes around the pores are mechanically ruptured (Column 3 lines 32-65). The rupturing of the pore walls in Tenneco results in pores which run perpendicular to the major surface of the foam layer.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 13-17, 25-31 and 33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McCormack (WO 95/16562).

McCormack is directed to a breathable film and a breathable, cloth-like film/nonwoven composite (Page 1 lines 8-9). The breathable film is comprised of an

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amorphous thermoplastic elastomer polymer such as linear low density polyethylene (page 10 lines 3-4). The glass transition temperature of linear low density polyethylene falls below 20° C. It is known in the art that the elastic polymeric materials used to make the breathable film are capable of being stretched at room temperature and, upon release of the stretching force, retracting to their original unstretched length. The film is formed by mixing the amorphous polymer base with a filler and then extruding that mixture into a film. Once the film is formed, it is stretched to make it porous and breathable. McCormack discloses a fibrous polyolefin nonwoven web which is thermally bonded to the breathable film (page 4-5 lines 37 and 1). The fibrous polyolefin nonwoven web reads on Applicant's unfoamed second layer. McCormack explains that a second fibrous polyolefin nonwoven web may be bonded to the film layer on a side of the film opposite the first fibrous polyolefin nonwoven web (page 9 lines 9-19). This three layer composite would read on Applicant's ABA structure. Additionally, McCormack states that the disclosed breathable film is stretched to produce a water vapor transmission rate of at least 100 grams per meter squared for 24 hours (page 6 lines 25-27). The breathable film/nonwoven composite of McCormack is disclosed as an efficient outer backing layer in diapers and other personal absorbent articles (Pages 6-7). This would result in an absorbent layer adjacent McCormack's outer nonwoven web layer which reads on Applicant's claimed layer on at least one A layer of a three layer ABA structure.

McCormack does not specifically disclose a breathable film having at least one major surface, having porosity in the direction perpendicular to that major surface, and

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having at least one ruptured cell. However, any film layer must inherently have at least one major surface. Additionally, because pores are three dimensional, they can always be referred to as perpendicular to any one side of the film in which they are a part. The film of McCormack is made by essentially the same process used by Applicant, and therefore, it is believed by the examiner that the film would contain at least one ruptured cell as a result of the stretching process. It would have been obvious to one of ordinary skill in the art to have stretched the elastomeric film to rupture the cells, thus creating pores perpendicular to the major surface, in order to increase the porosity of the film resulting in the desired and disclosed water vapor transmission rate.

13. Claims 13-17, 25-31 and 33 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McCormack et al. (USPN 6111163).

USPN 6111163 ('163) is directed to a breathable laminate including at least one support layer and an oriented microporous film that includes an amorphous thermoplastic elastomeric resin such as linear low-density polyethylene (Column 2 lines 13-15, 25). The support layer of '163 is a fibrous nonwoven web such as various types of polypropylene (Column 7 lines 58-59, Column 8 lines 7-11) which reads on Applicant's non-porous, unfoamed polymeric layer. '163 discloses that many of the elastic polymeric materials used to make the breathable film are capable of being stretched at room temperature to at least twice their original length and, upon release of the stretching force, will retract approximately to their original unstretched length

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(Column 2 lines 32-36). '163 is also directed to the production of a three layer laminate which is comprised of a breathable film sandwiched between two fibrous non-woven webs (Column 9 lines 6-17). The overall water vapor transmission rate of the film of '163 is at least 300 grams per meter squared per 24 hours (Column 2 lines 39-40). The breathable film/nonwoven composite of '163 is disclosed as an efficient outer backing layer in diapers and other personal absorbent articles (Column 2 lines 45-52). This would result in an absorbent layer adjacent McCormack's outer nonwoven web layer which reads on Applicant's claimed layer on at least one A layer of a three layer ABA structure.

'163 does not specifically disclose a breathable film having at least one major surface, having at least one ruptured cell, and having porosity in the direction perpendicular to that major surface. However, any film layer must inherently have at least one major surface. Additionally, because pores are three dimensional, they can always be referred to as perpendicular to any one side of the film in which they are a part. The film of '163 is made by extruding the elastomeric resin and then stretching that resulting film to produce oriented micropores within that film (Column 6 lines 23-31). This is essentially the same process used by Applicant, and therefore, it is believed by the examiner that the film would contain at least one ruptured cell as a result of the stretching process. It would have been obvious to one of ordinary skill in the art to have stretched the elastomeric film to rupture the cells, thus creating pores perpendicular to the major surface, in order to increase the porosity of the film resulting in the desired and disclosed water vapor transmission rate.

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14. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCormack (WO 95/16562 and USPN 6111163) as applied to claim 25 above, and further in view of Bierenbaum (USPN 3426754).

McCormack is directed to a breathable film/nonwoven laminate which may be used for various surgical supplies and personal care absorbent articles including bandages. McCormack, however, does not disclose the application of a pressure sensitive adhesive to the breathable film/nonwoven web composite. Bierenbaum is directed to a breathable, porous, pressure-sensitive adhesive dressing for use as a bandage comprised of an open-celled porous backing coated with a pressure sensitive adhesive (Column 1 lines 12-20). It would have been obvious at the time the invention was made to one of ordinary skill in the art to combine the teachings of McCormack and Bierenbaum motivated by the desire to produce a bandage with means to be temporarily adhered to the body.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leanna Roche whose telephone number is 703-308-6549. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 703-308-1261. The fax phone


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numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



lmr
February 26, 2001



BLAINE COPENHEAVER
PRIMARY EXAMINER